



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/767,512 | 01/22/2001 | William Vong | MS1-155USC3 | 3413 |

22801 7590 12/15/2004

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

| EXAMINER |
|----------|
|----------|

SHIN, CHRISTOPHER B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2182

DATE MAILED: 12/15/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,512

Applicant(s)

VONG ET AL.

Examiner

Christopher B Shin

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20,23 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 18-19, 23 & 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2182

DETAILED ACTION

1. After careful consideration of the APPEAL BRIEF received August 20, 2004, the examiner withdraws the finality of the last office action and issues a new rejection.

Claims 18-20, 23, and 41-46 are pending in the application; claim 20 is allowable over the prior art of record, and claims 18-19, 23, and 41-46 have been rejected as follows.

Establishment of Well Known Prior Art

2. Examiner would like to establish that LED (light emitting diode/device) are well known as being one of the common elements in the portable computer environment (supported by Paulick 6,018,584 and many more in the art). Furthermore, the color, shape, size, and location of such LED is clearly within the choice of the designer, as supported by the examiner cited prior art of record and more not yet cited but the examiner would like give official notice on such well known design choices. In addition, in most cases, the LEDs are used to notify the user of a certain event or condition to a user. For example, every laptop, handheld/palm top, desk top, and main frame, peripherals, and more usually have one or more LEDs to indicate conditions or notify the user events. The examiner also gives official notices on such well- common knowledge.

For the above reasons, the examiner strongly believes that the present claimed inventions are not allowable over the prior art of record. The there are many prior art teaches the claimed functional equivalent of notifying events from multiple direction due to a physical shape/design of LEDs.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2182

4. Claims 18-19, 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto et al. (5,552,976).

a. The examiner relies on the examiner-cited references as being the well-known common knowledge in the art LED alert/display notification technique as stated above.

b. As for claim 18, in figure 7, the Seto reference teaches the claimed limitations as follows:

Claims 18 & 42-46 Seto (figure 7)

- Portable handheld computing device comprising
 - Feature of figure 1
- Casing having upper and lower surfaces
 - Feature of 8b and bottom (8b) sides of figure 7
- Opposing front and back side surfaces
 - Feature of front and back (not visible) of figure 7
- Opposing end surfaces
 - Feature of left front (8a) and right side of figure 7
- The ends being dimensionally shorter than the front and back side surfaces
 - Feature of figure 7 as discussed above, note that the left front side are not discussed (5) is not included in this rejection section
- Light emitting device (LED) mounted externally on the casing, the LED being positioned on the upper surface and wrapping around to
 - Feature of figure 7 (as interpreted above) and in view of figure 1 (254)
- And being raised on one of the end surfaces
 - obvious feature of manufacturing/design variations, as will be discussed below
- LED being activated upon occurrence of an event to notify a user
 - Inherent/obvious feature of (254)
- Positioned such that the LED is visible from the upper surfaces, one of the side surfaces, and one of the end surfaces
 - Feature of figure 7 (as interpreted above) and in view of figure 1 (254)
- Claims 43-46
 - Feature of figure 7 with different interpretations of surfaces respective to the claims 43-46

The difference between the claimed invention and the teachings of the Seto reference is that the Seto reference does not expressly disclose the exactly same physical shape of LED. However, such difference in limitation is a design choice matter to one having ordinary skill in the art. The examiner takes official notice on such design choice matter such as off button integration. This is because the physical situation/position of the LED is chosen by the designer with a motivation of choosing better visible location and/or better looking (trendy look); one skilled artisan can easily choose a specific location (one of three obvious locations such as raised, lowered, flushed) or more than one locations (for example, the designer can easily choose to have raised, lowered or flushed position) to serve the purpose of alerting a user. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention form the teachings of the Seto reference, for the reasons stated above.

c. As for claim 19, the Seto reference teaches the claimed limitations as follows:

Claim 19

Seto et al.

- Portable handheld computing device comprising
 - Feature of figure 7
- Casing having a base and a lid
 - feature of figure 7, (2) being a base and (8) being a lid
- The LED being activated upon occurrence of an event to notify a user
 - Obvious/inherent feature of (254)

The difference between the claimed invention and the teachings of the Seto reference is that the Seto reference does not expressly/identically disclose the exactly the same shaped "lid"; however, such difference in limitation is obvious from the teachings of Seto in view of the dictionary definition of Merriam Webster Dictionary, 10th edition - the Dictionary defines the lid as "something that confines, limits, or suppresses". Therefore, it would have been obvious at the time

Art Unit: 2182

the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the Seto reference, for the reasons stated above and in the discussion details of the claim 18.

5. Claims 23 & 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto et al. (5,552,976) in view of Maddrell et al (6,041,215) or Weber (4,056,701) or Wunsch et al. (4,454,596) or Hidaka (5,606,712).

a. The examiner relies on the examiner-cited references as being the well-known common knowledge in the art LED alert/display notification technique as stated above.

b. The teachings of the parent claim 18 are similarly applied in this rejection.

c. The difference between the claimed invention and the teachings of the Seto reference is that the reference does not expressly disclose the exactly same physical shape of LED (i.e., physical situations of the LED) & the off button integration. However, such difference in limitation is a design choice matter to one having ordinary skill in the art. The examiner takes official notice on such design choice matter such as off button integration (e.g., as can be seen from the examiner cited references, Maddrell et al (6,041,215) or Weber (4,056,701) or Wunsch et al. (4,454,596) or Hidaka (5,606,712), all teach the well known light emitting device & button combinations). This is because the physical situation of the LED is chosen by the designer with a motivation of choosing better visible location; one skilled artisan can easily choose a specific location or more than one locations to serve the purpose of alerting a user. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the Seto reference, for the reasons stated above.

Art Unit: 2182

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B Shin whose telephone number is 571-272-4159. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Shin
Primary Examiner
Of 2182

November 28, 2004
CBS

